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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,974	11/30/2001	Haruo Ichikawa	Q66892	4743

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EXAMINER

FOX, CHARLES A

ART UNIT PAPER NUMBER

3652

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Arguments

The reply brief filed December 20, 2004 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Applicant's arguments filed December 20, 2004 have been fully considered but they are not persuasive. Regarding the grouping of claims set forth by the examiner, there is no error on the part of the examiner. In the appeal brief filed by the appellant they present arguments for claims 1 and 4 as a group, they then present the arguments for claims 5 and 10. The arguments for claims 5 and 10 are they are allowable based on their dependency on claim 4, as such they will stand or fall with claim 4. The arguments in the appeal brief supporting claims 8 and 9 are also based upon their dependency on claim 4, so they will stand or fall with claim 4. Appellant has not set forth any deficiencies in the rejections of claim 5 and 8-10 other than their dependency on claim 4 which the examiner maintains is properly rejected. As such it is proper for the examiner to group claims 1,4,5 and 8-10 together as in the examiners answer mailed on October 20, 2004.

The grouping of claims 11-16 by the examiner is also supported by the argument set forth by the appellant in the appeal brief as the only arguments for claims 15 and 16 is that they are dependent upon claim 11. The examiner hold this grouping is proper as there are no arguments presented by the appellant to counter the rejection of claim 15 and 16 save the dependency of those claims. Appellant has not given any reasons why claims 5 and 8-10 should not stand or fall with claims 1 and 4 or why claims 15 and 16

should not stand or fall with claims 11-14. The mere assertion that the dependent claims are patentable is not a proper argument. Therefore the examiner stands behind the grouping of the claims as presented in the examiner's answer.

In regards to the examiner's answer dealing with the rejection of claims 1 and 4, the examiner disagrees with the appellant. Regarding the use of hindsight to formulate the rejections the appellant is incorrect. The Swain reference teaches using any type of known mandrel in their invention. As the Van Breen mandrel is well known in the art, it would have been looked to for guidance as suggested by the Swain reference. As such the rejections are proper as addressed in the examiner's answer.

Regarding the arguments submitted regarding claim 11 Swain does teach a mechanism for moving roll onto and off of their mandrel. This mechanism may not be driven, but that is a limitation that is not within the claim. The claims are examined based upon the limitations they have, and not those that may be read into them. As such Swain teaches the structure of claim 11 as it is written, while other structure may be inferred from the specification the only structure examined is what is in the claims themselves. The examiner maintains the rejection of claim 11 is correct.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 703-605-4294. The examiner can normally be reached between 7:00-5:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached at 703-308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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